

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DONALD L. MOBLEY et al.

Appeal No. 2005-1753
Application No. 09/992,455

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 10 and 12. Claims 11, 13 to 15 and 21 to 27, the only other claims pending in this application, have been allowed¹.

We AFFIRM-IN-PART.

¹ The rejection of claims 21 to 27 under 35 U.S.C. § 112, second paragraph, made in the final rejection was withdrawn by the examiner in the answer (p. 10).

BACKGROUND

The appellants' invention relates to hospital and long term care beds and more particularly to hospital beds having four wheels or casters attached to the base frame for rolling the bed from location to location and a braking mechanism for maintaining the bed in a desired location (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Stosberg et al. (Stosberg)	3,705,438	Dec. 12, 1972
Wisecarver	3,880,394	Apr. 29, 1975
Reichow et al. (Reichow)	5,269,388	Dec. 14, 1993
Hall	5,330,064	July 19, 1994
Sather ²	5,310,482	May 10, 1994

Claims 1 to 4, 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Reichow in view of Hall.

² The examiner cites Sather on page 10 of the answer. This reference was not included in any statement of any rejection. However, the examiner appears to apply Sather against claim 4.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Reichow in view of Hall as applied to claim 1, and further in view of Wisecarver and Stosberg.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Reichow in view of Hall and Stosberg.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Reichow in view of Hall as applied to claim 1, and further in view of Stosberg.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hall in view of Wisecarver and Stosberg.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed September 30, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed July 9, 2004) and reply brief (filed December 2, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants'

invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

Claim 1

We sustain the rejection of claim 1 under 35 U.S.C. § 103.

Claim 1 reads as follows:

A patient support apparatus comprising:
a base frame,
a patient support coupled to the base frame,
a plurality of casters each having a sleeve, and
a plurality of caster mounting tubes, each mounting tube including a plurality of external side walls surrounding an opening, each of the external side walls having an interior surface facing inwardly toward the opening and an

exterior surface facing outwardly away from the opening, the interior surface being configured to receive in abutting relationship the sleeve of a caster, the plurality of external side walls including a generally planar first external side wall, a first exterior surface of the generally planar first external side wall abutting the base frame, the mounting tube being connected to the base frame by welds located adjacent the generally planar first external side wall.

Reichow's invention relates generally to hospital beds and the like, and more particularly concerns an improved weighing system for use with such beds. As shown in Figures 1-2, the weighing bed 10 includes an articulated patient support assembly 12, an upper bed frame 14 and a lower bed frame 16. The lower bed frame 16 includes two elongated longitudinal members 42 and 44. The longitudinal members flare outwardly in the vicinity of each end, terminating in caster assemblies 45. Extending between the two longitudinal members 42 and 44 of the lower bed frame 16 are two lateral braces 48 and 50. The lateral braces are positioned approximately at the point along the length of each longitudinal member where the longitudinal member begins to flare outwardly.

Hall's invention is related to a support assembly for a holding rack. Hall teaches (column 1, lines 7-9) that "[i]t should be understood that the support assembly according to the invention could be used to support objects others than holding racks." Figures 1-3 show a support assembly 10 for a holding rack 20. Holding rack 20

includes a frame 24 have a first frame member 28 and a second frame member 32 extending transversely from first frame member 28 and joined thereto at a corner 36. Second frame member 32 has a top surface 33 and includes an outer perimeter defining a vertical face 38. An upright 40 is located adjacent corner 36 of frame 24. An exterior support member 44 is disposed between upright 40 and outer perimeter or vertical face 38 of frame 24. A conventional caster 50 is positioned below and rotatably secured relative to upright 40 and relative to exterior support member 44 by means of an extension 54.

Hall teaches (column 4, line 55-64) that:

The end user or, preferably, factory personnel, attach exterior support member 44 to vertical face 38 of frame 24, such as by welding, rivets, or spot welding. Preferably, holding rack 20 is shipped disassembled. When holding rack 20 is to be used, upright 40 is inserted into exterior support member 44 from above, as viewed in FIG. 2. Then, extension 54 is inserted into the interior of upright 40 from below. After the apertures in each of upright 40, exterior support member 44 and extension 54 have been aligned, bolt 72 is inserted therethrough.

Figure 5 of Hall shows a support assembly 210 attached obliquely at a corner 236 defined by a first frame member 228 and a second frame member 232. One or more welds 239 may be provided for strengthening the connection between an outer perimeter or vertical face 238 of second frame member 232 and an exterior support member 244. An upright 240 receives an extension 254 of a caster 250.

Hall teaches (column 6, line 28-40) that:

It has been found that the provision of snugly fitting uprights receiving extensions of conventional casters, and then being received in turn by the novel exterior support members, yields a strong construction even though the assembly is by means of a detachable fastener, such as a bolt, and not by welding. It has been discovered that, apparently, given the close tolerances, little movement or deflection of upright 40 is possible, so that a relatively weak and inexpensive material, such as aluminum or plastic, can be used for upright 40, while the remaining components are made of carbon steel or stainless steel.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Reichow and claim 1, it is our opinion that the differences are: (1) the plurality of casters each having a sleeve, and (2) each caster mounting including a plurality of external side walls surrounding an opening, each of the external side walls having an interior surface facing inwardly toward the opening and an exterior surface facing outwardly away from the opening, the interior surface being configured to receive in abutting relationship the sleeve of a caster, the plurality of external side walls including a generally planar first external side wall, a first exterior surface of the generally planar first external side wall abutting the base frame,

the mounting tube being connected to the base frame by welds located adjacent the generally planar first external side wall.

With regard to these differences, in applying the above-noted test for obviousness, we reach the conclusion that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the caster assemblies of Reichow and their attachment to the lower bed frame of Reichow as suggested and taught by Hall's support assembly. Specifically, it would have been obvious to (1) weld a plurality of exterior support members as suggested by Hall's member 44 to the lower bed frame of Reichow; (2) provide each caster of Reichow with an extension as suggested by Hall's extension 54; and (3) snugly fit (i.e., in an abutting relationship) each caster extension into a respective exterior support member as suggested by Hall's teaching that a snug fitting yields a strong construction.

In view of our determination above that the subject matter of claim 1 would have been obvious at the time the invention was made to a person having ordinary skill in the art we find the appellants arguments regarding the patentability of claim 1 to be unpersuasive. In that regard, while Hall's extension 54 does not abut the exterior support member 44 due to the presence of upright 40, Hall does teach that extension 54 abuts upright 40 which abuts the exterior support member 44 to provide a strong

connection and that his support assembly could be used to support objects others than holding racks. In our view, an artisan would have known when using Hall's support assembly to support a bed, upright 40 would be omitted and extension 54 would be made to abut the exterior support member 44 to obtain a snug fitting which yields a strong construction.³

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed.

Claims 2, 3, 8 and 10

The appellants have grouped claims 1 to 3, 8 and 10 as standing or falling together.⁴ Thereby, claims 2, 3, 8 and 10 fall with claim 1. Thus, it follows that the decision of the examiner to reject claims 2, 3, 8 and 10 under 35 U.S.C. § 103 is also affirmed.

³ We point out that all of the features of the secondary reference need not be bodily incorporated into the primary reference (see In re Keller, *supra*, at 642 F.2d 425, 208 USPQ 881) and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (see Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)).

⁴ See page 5 of the appellants' brief.

Claim 4

We will not sustain the rejection of claim 4 under 35 U.S.C. § 103.

Claim 4 reads as follows:

The apparatus of claim 3, wherein the first external side wall abutting the base frame is formed to include a hole, the base frame is formed to include a hole, the hole in the base frame is aligned with the hole in the first external side wall, and both holes are located between the first and second welds.

In rejecting claim 4, the examiner took Official Notice that it is old and well known to use rivets and welding together to better align and secure the two parts of a device. In addition, the examiner cites Sather on page 10 of the answer for support of the Official Notice. The examiner concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used rivets and welds to secure the exterior support members as suggested by Hall's member 44 to the lower bed frame of Reichow in order to more securely attach the exterior support members to the lower bed frame so as to better support the weight of the apparatus.

In our view, the examiner conclusion of obviousness is not supported by the applied evidence. The mere fact that it was known to use rivets and welding together to better align and secure two parts of some device does not, ipso facto, make it obvious

to have further modified Reichow's bed so as to arrive at the subject matter of claim 4. We believe the examiner engaged in impermissible hindsight in an attempt to reconstruct the claimed invention.

For the reasons set forth above, the decision of the examiner to reject claim 4 under 35 U.S.C. § 103 is reversed.

Claims 5, 6, 9 and 12

We will not sustain the rejection of claims 5, 6, 9 and 12 under 35 U.S.C. § 103.

Claims 5, 6, 9 and 12 recite in one manner or another that the sleeve of each caster is cylindrical. To meet this limitation, the examiner relies on Stosberg alone or in combination with Wisecarver. We have reviewed the teachings Stosberg and Wisecarver and find no suggestion therein that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have further modified the Reichow in view of Hall combination (claims 5, 6 and 9) or Hall alone (claim 12) so as to make the extension (i.e., sleeve) cylindrical. For this reason, the decision of the examiner to reject claims 5, 6, 9 and 12 is reversed.

Claim 7

We sustain the rejection of claim 7 under 35 U.S.C. § 103.

Claim 7 reads as follows:

A patient support apparatus comprising:
a base frame,
a patient support coupled to the base frame,
a plurality of casters each having a sleeve,
a plurality of caster mounting tubes, each mounting tube having an interior configured to receive the sleeve of a caster, a plurality of external side walls including a generally planar first external side wall abutting the base frame, the mounting tube being connected to the base frame by welds located adjacent the first external side wall, and
a plurality of set screws configured to orient the plurality of casters and wherein the caster mounting tubes are each formed to include an opening configured to receive one of the set screws.

Stosberg's invention relates to a castor. As shown in Figure 4, the castor includes a casing (i.e., sleeve, extension) 24 fitted into a tubular foot (mounting tube, support member) 24 of a bed frame and secured therein by a screw 25. As shown in Figure 4, the tubular foot is formed with an opening configured to receive the set screw.

Based on our analysis and review of Reichow and claim 7, it is our opinion that the differences are: (1) the plurality of casters each having a sleeve, (2) each caster mounting having an interior configured to receive the sleeve of a caster, a plurality of

external side walls including a generally planar first external side wall abutting the base frame, the mounting tube being connected to the base frame by welds located adjacent the first external side wall, and (3) a plurality of set screws configured to orient the plurality of casters and wherein the caster mounting tubes are each formed to include an opening configured to receive one of the set screws.

With regard to these differences, in applying the above-noted test for obviousness, we reach the conclusion that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the caster assemblies of Reichow and their attachment to the lower bed frame of Reichow as suggested and taught by Hall's support assembly. Specifically, it would have been obvious to (1) weld a plurality of exterior support members as suggested by Hall's member 44 to the lower bed frame of Reichow; and (2) provide each caster of Reichow with an extension as suggested by Hall's extension 54. We further reach the conclusion that it would have been additionally obvious at the time the invention was made to a person having ordinary skill in the art to have further modified the caster assemblies of Reichow as modified by Hall's support assembly to have utilized set screws as suggested and taught by Stosberg to secure the extensions to the exterior support members.

In view of our determination above that the subject matter of claim 7 would have been obvious at the time the invention was made to a person having ordinary skill in the art we find the appellants arguments regarding the patentability of claim 7 to be unpersuasive as pointed out above with respect to claim 1. In addition, the substitution of Stosberg's set screw for Hall's bolt 72 is a substitution of known alternatives. In this regard, it must be borne in mind that where two known alternatives are interchangeable for their desired function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious. See In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 568, 152 USPQ 618, 619 (CCPA 1967).

For the reasons set forth above, the decision of the examiner to reject claim 7 under 35 U.S.C. § 103 is affirmed.

CONCLUSION


To summarize, the decision of the examiner to reject claims 1 to 10 and 12 under 35 U.S.C. § 103 is affirmed with respect to claims 1 to 3, 7, 8 and 10 and reversed with respect to claims 4 to 6, 9 and 12.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2005-1753
Application No. 09/992,455

Page 17

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